


PATENT
RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3636

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Christine Sherwood

Appl No. : 10/779,467 Confirmation No. 5554
Applicant : Jochen Hofmann, et al.
Filed : February 12, 2004
Title : SEAT ASSEMBLY FOR A MOTOR VEHICLE SEAT

TC/A.U. : 3636
Examiner : Joseph F. Edell

Docket No. : 51900/M521

Customer No. : 23363

REQUEST FOR RECONSIDERATION OF FINALITY OF REJECTION

Mail Stop AF
Commissioner for Patents
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Alexandria, VA 22313-1450

Post Office Box 7068
Pasadena, CA 91109-7068
November 19, 2007

Commissioner:

A Final action was mailed on October 15, 2007. Applicant respectfully submits that the finality of the rejection is premature and requests that the finality be withdrawn for the following reasons:

1. In an action mailed March 21, 2007, claims 1, 24, 25 and 29 were objected to because of "informalities," namely the Examiner requested applicant to change "constituting" to --comprising--.

2. In a response to Office action mailed July 23, 2007, applicant followed the Examiner's recommendation, and amended claims 1, 24, 25 and 29 to correct the informality raised by the Examiner.

3. No other changes were made to claims 1, 24, 25 and 29.

4. In the Final action mailed October 15, 2007, claims 1 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Billen in view of Eubank. Claims 25 and 29 were rejected further in view of Sakamoto.

5. The rejections in the Final action were never previously asserted against claims 1, 24, 25 and 29. On page 6 of the Office action, the Examiner agrees that these are new grounds of rejection.

6. On page 7 of the Final action, the Examiner states that applicant's amendment necessitated the new grounds of rejection.

7. Applicant respectfully submits that because the amendments to claims 1, 24, 25 and 29 were merely formal, and in response to the Examiner's previous formality objection, the current action should not have been made final.

8. MPEP 706.07(a) recites that an action should not be made final if it includes a rejection, on prior art not of record," of any claim amended to include limitations which should reasonably have been expected to be claimed."

9. Clearly, in view of the Examiner's "Claim Objections" in the prior Office action, the assertion of objections based on "informalities," the suggestion of how to correct the informality, and the requirement by the Examiner to correct, it was entirely reasonable for the applicant to amend the claims as requested, without fear of a "Final" rejection in the next action. In accordance with the language of MPEP 706.07(a), the claims were amended to include limitations which should reasonably have been expected to be claimed.

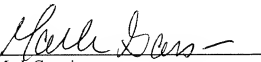
Appln No. 10/779,467
Amdt date November 19, 2007
Reply to Office action of October 15, 2007

10. On October 29, 2007, the undersigned contacted Examiner Edell to request withdrawal of the finality of the rejection as premature. The Examiner asserted that by amending the claim from a "closed type" claim to an "open-type" claim, applicant broadened the claim and therefore the finality was proper.

11. Applicant respectfully disagrees. First, the finality is contrary to MPEP 706.07(a), because the amendment "should reasonably have been expected," as discussed above. Second, applicant does not agree that "constituting" is necessarily closed-type language (see, e.g. MPEP 2111.03, "consisting of"). Third, even if the Examiner considers the amendment to broaden the claim, the prior rejection would have still applied because the claim is now broader. No change in the prior rejection was needed and it still should have been adequate. The Examiner, however, modified the rejection with new art not previously cited, which indicates that the Examiner did not consider the previous rejection to be adequate for the new claim or the old claim.

12. In view of the above, applicant respectfully requests that the finality of the rejection in the Office action, mailed October 15, 2007 be withdrawn as premature and the time to respond to the Office action be reset.

Respectfully submitted,
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